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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/073,668	02/08/2002	Heinrich Englert	P6608.0US	4591
30008 7590 04/16/2007 GUDRUN E. HUCKETT DRAUDT LONSSTR. 59 WUPPERTAL, 42289 GERMANY			EXAMINER PETERSON, KENNETH E	
			ART UNIT	PAPER NUMBER
			3724	
SHORTENED STATUTORY PERIOD OF RESPONSE		MAIL DATE	DELIVERY MODE	
3 MONTHS		04/16/2007	PAPER	

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary

Application No.

10/073,668

Applicant(s)

ENGLERT ET AL.

Examiner

Kenneth E. Peterson

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 28 March 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 2,4-7 and 16-31 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 2,4-7 and 16-31 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____.

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1. Primary Examiner Charles Goodman has departed the office. Expert Primary Examiner Ken Peterson has taken over the case. Applicant's appeal brief, received on 28 March 07, has been considered.

An appeal conference was held on 09 March 07 with Supervisory Primary Examiner Boyer Ashley, Supervisory Primary Examiner Derris Banks as well as Expert Primary Examiner Ken Peterson.

During this conference, it was determined that the 103 rejection should be maintained and that the new matter rejection, the drawing objection and the 112, 2nd paragraph rejections should be dropped. Also it was determined that two additional 103 rejections and additional 112, 2nd paragraph rejections should be applied. It would be inappropriate to continue to the board of appeals without providing all important rejections, so prosecution is hereby reopened to add the additional rejections, which shall be non-final.

2. Examiner requests the following information;

In regards to DE 3927230 to Englert; Examiner would like a more detailed explanation of the motion of the jointing stones relative to the cutting blade. Since Englert is also the current inventor, it seems that such information should be readily attainable. In particular, Examiner would like to know the length of the jointing stone stroke relative to the length of the cutting edge, and whether or not the jointing stone stroke went past the end of the cutting edge. Photographs or videos of the machine operating would help prosecution. Is a full English translation available? Also desired is

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any other public art or public recollections of Mr. Englert and company that may be pertinent.

3. Claims 5 and 16 are objected to for the following reason;

In each of claims 5 and 16, there is a method step in the preamble that should be in the body of the claims instead. The step of radially advancing the stone should be removed from the preamble and placed in the body of the claim to make more clear that it is a positive recitation.

4. Claims 2,4-7 and 16-31 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

All of the independent claims start with "A method of jointing" and at least claims 5 and 16 have the phrase "performing during jointing". The scope of the term "jointing" is not clear. A review of the prior art shows that in some cases "jointing" is nothing more than co-extensive sharpening. In other cases, jointing refers to unclamping the blade, aligning it with the stone, and reclamping the blade. Accordingly, it is not clear what, if any, method steps should be inferred by the "jointing" terminology employed in the claims. It is recommended that Applicant replace the word jointing in the claims with less vague language. Attempts to define "jointing" in the specification or remarks is unlikely to make the claim definite.

In regards to claims 4, 19 and 22, it is not clear how stroke speed can be compared to rotary speed, since they are measured in different units (m/s versus rpm). Accordingly, it is not clear what would or would not infringe on this claim.

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 16-19, as best understood, are rejected under 35 U.S.C. 103(a) as being unpatentable over Sloan (1,531,350), who shows a jointing method with most of the recited limitations including radially advancing a jointing tool (27) by pivoting it about an axle (19), and axially reciprocating the jointing tool by a stroke length that is shorter than the length of the jointing tool (lines 53-54, 1st column on page 2).

Sloan is silent in regards to what his jointing tool is made out of. Examiner takes Official Notice that it is well known for sharpening tools such as this to be made of stone. An example of this is the patent to Ruscitti (2,574,499), who uses a stone (40) to sharpen and joint a saw blade. It would have been obvious to one of ordinary skill in the art to have made Sloan's jointing tool out of stone, as is well known and taught by Ruscitti, since stone is a well known sharpening material.

7. Claims 2, 4-7 and 16-31, as best understood, are rejected under 35 U.S.C. 103(a) as being unpatentable over Mann (2,864,210), who shows a jointing machine having

many of the recited limitations including the steps of radially advancing the jointing stone and then axially reciprocating the jointing stone.

Mann's jointing stone is not as axially long as claimed by Applicant. However, the courts have long held that it is obvious to increase something to increase the effect it has. For example, see St. Regis Paper Co. v. Bemis Co., Inc. 193 USPQ 8, 11. In this case, it is obvious to make the stone axially longer to increase its sharpening effect. The courts have also ruled that it is obvious to change a parameter of an invention so long as this does not produce any new or unexpected results that are different in kind and not merely in degree from the results of the prior art. For example, see In re Aller, 105 USPQ 233. In this case, increasing the axially length of the stone produces an *expected* result of increasing the sharpening action, that is merely a difference of degree, and not a difference of kind.

Accordingly, it would have been obvious to make the stone be any size greater than its current size, since this obviously would increase the sharpening action. Indeed, it is difficult to conceive of a more obvious method of increasing the sharpening action. To have made the stone longer than half the cutting edge length (claims 16,23,24 and 28) would have been obvious. To have made the stone longer than 2/3 the cutting edge length (claims 25,27) would have been obvious. To have made the stone longer than the cutting edge length (claim 5) would have been obvious. To have made the stone longer than the cutting edge length plus the stroke (claim 2) would have been obvious. It's as obvious as making a car larger to hold more people.

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In regards to at least claims 6,7,20 and 21, Mann has only one stone, but it is well known to employ two or more, as seen in Englert (DE 3927230)(stones 13). It would have been obvious to one of ordinary skill in the art for Mann to have employed multiple stones, as taught by Englert, in order to have a multiplied sharpening effect.

8. Claims 2,4-7 and 16-31, as best understood, are rejected under 35 U.S.C. 103(a) as being unpatentable.

It is well known for a radially advancable jointing stone to be longer than the cutting edge upon which it is employed. Examples of this can be seen the patents to Thien (4,581,856) (figure 6) and Fosterling (1,114,743)(figure 2). Neither Thien nor Fosterling reciprocate their stones axially. However, it is well known for jointing stones to be reciprocated axially. Examples of this can be seen in the patents to Englert (DE3927230), Mann (2,864,210) and in Applicant's admitted prior art figure 6. This axial motion provides an important additional sharpening feature.

It would have been obvious to one of ordinary skill in the art to have modified the likes of Thien or Fosterling by making the stone reciprocate axially, as taught by the likes of Englert, Mann and the admitted prior art, in order to achieve extra sharpening. The stroke would intrinsically be multiple times shorter than the cutting edge and multiple times shorter than the stone, since having longer strokes would result in the ends of the jointing stone not being efficiently employed.

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In regards to at least claims 2,17, it would have been obvious to have made the jointing stone slightly longer (by the length of the stroke), otherwise the middle of the cutting edge would be ground more than the ends of the cutting edge.

In regards to at least claims 6,7,20 and 21, Thien and Fosterling have only one stone, but it is well known to employ two or more, as seen in Englert (DE 3927230)(stones 13). It would have been obvious to one of ordinary skill in the art for Thien or Fosterling to have employed multiple stones, as taught by Englert, since this is an art recognized equivalent known for the same purpose.

9. Applicant's arguments filed in the appeal brief have been fully considered but they are not persuasive.

Applicant's new figure 7 has been accepted.

Applicant argues that Thien knew about axially moving stones, but chose not to move the stone axially. This is true. Applicant perceives this to be an indication of non-obviousness. However, the act of not pursuing a line of thought is most definitely *not* indicative of non-obviousness. Every day, a person makes dozens of decisions *not* to do things that are obvious. This hypothetical person was not necessarily influenced by non-obviousness, but instead was most likely influenced by time or money constraints. Likewise, there is no evidence that Thien thought axial stone motion in his device to be non-obvious, and it is much more likely that Thien did not pursue it due to time or money constraints.

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It is true that the references teach either long stones OR axial reciprocation, but not both. However, one must look at the art as a whole to see whether or not it is obvious to have both long stones AND axial reciprocation. Both are desirable features (as espoused by the respective references), so why has nobody done both? The answer is because it costs more and takes more time, not because it's non-obvious.

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kenneth E. Peterson whose telephone number is 571-272-4512. The examiner can normally be reached on Mon-Thur, 7:30-4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Boyer Ashley can be reached on 571-272-4502. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

kp



KENNETH E. PETERSON
PRIMARY EXAMINER